



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/458,019	06/01/95	JOHNSON	E A-6274-1

18M2/1113  
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EXAMINER

ART UNILING PAPER NUMBER

1808

16

DATE MAILED: 11/13/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on Sept 30, 1996  This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1.  Claims 25-34 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 25-34 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

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EXAMINER'S ACTION

15. Receipt is acknowledged of the amendment filed September 30, 1996.

16. Claims 25-34 remain present in the instant application.  
5 Claims 1-24 were previously cancelled.

17. Claims 25-34 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5,356,810. Although the conflicting 10 claims are not identical, they are not patentably distinct from each other because the patented claims are within the scope of the claimed subject matter.

15 The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 2d 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 20 1993).

25 A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

30 Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

It is noted that there is one inventor in common with the patent and the application, see MPEP 800-13, rev 1 Sept 1995, chart IIB-conflicting claims between APPLICATION AND A PATENT.

5           **The arguments submitted have been deemed not to be persuasive since the filing date is not an issue in a Double Patenting of the Obvious-type.**

10          19.       The following is a quotation of the first paragraph of 35 U.S.C. § 112:

15           The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

20          The specification stands objected to under 35 U.S.C. § 112, first paragraph, as enabling for the claimed microorganisms in accordance with the U.S. Rules of Deposits.

25          It is apparent that the additional strains are required to practice the claimed invention(s) as recited in the claims. As a required element it must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. If it is not so obtainable or available, the enablement requirements of 35 U.S.C. 112, first paragraph, may be satisfied by a deposit of these additional strains. See 37 C. F. R. 1.802.

30          If a deposit has not been supplied or made under the Budapest Treaty, then an affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements, See 37 CFR 1.808.

5 If a deposit is not made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made at an acceptable depository and that the following criteria have been met:

10 a) during the pendency of the application, access to the deposit will be afforded to one determined by the Commissioner to be entitled thereto;

15 b) all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent;

20 c) the deposit will be maintained for a term of at least thirty (30) years and at least five (5) years after the most recent request for the furnishing of a sample of the deposited material;

25 d) a viability statement in accordance with the provisions of 37 CFR 1.807;

and

30 e) the deposit will be replaced should it become necessary due to inviability, contamination or loss of capability to function in the manner described in the specification.

35 In addition, the identifying information set forth in 37 CFR 1.809(d) should be added to the specification. See 37 CFR 1.803-37 CFR 1.809 for additional explanations of these requirements.

40 The arguments are not persuasive for one of ordinary skill in the art to reproduce all of the mutants encompassed by the claimed inventions since the claims are drawn to products and not processes.

**Will accept product by process claims to claim all additional strains not deposited**

45 20. Claims 25-34 stand rejected under 35 U.S.C. § 112, first paragraph as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make.

The following decisions which may be pertinent to the claimed language which may be extremely broad for the microorganism, see: In re Fisher, 168 USPQ 18, 24 (June 11 1970)

5 Such improvements, while unobvious from his teachings, are still within his contribution, since the improvement was made possible by his work. It is equally apparent, however, that he must not be permitted to achieve this dominance by claims which are insufficiently supported and hence not in compliance with the first  
10 paragraph of 35 U.S.C. 112. that paragraph requires that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.....In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the  
15 scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.

In view of the broad claimed language, the above statement:

20 It is equally apparent, however, that he must not be permitted to achieve this dominance by claims which are insufficiently supported and hence not in compliance with the first paragraph of 35 U.S.C. 112. that paragraph requires that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art..

Further decision, see Fiers v. Sugano 25 USPQ2d. 1601. The decision clearly states:

30 "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived." This above statement is complete concordance with the above decision to In re Fischer. Applicant is absolutely not entitled to the broad claimed language for the "mutant Phaffia" which "requires a precise definition, such as by structure, formula, chemical name, or physical properties, as we have held, then a description also requires that degree of specificity." Also, stated "We thus determined that, irrespective of the complexity or simplicity of the method of isolation employed, conception of a DNA, like conception of any chemical substance, requires a definite of that substance other than by its functional utility." Applicant does not teach in the instant specification any and all mutant strains to produce pigments at a certain level  
45 but only specific mutant strains.

5           **The arguments that the scope of the claims are enabling in view of the alleged screening methods to obtain astaxanthin mutants is not fully persuasive. As indicated above, if the claims are drawn to product by processes, the claims would be considered favorably for allowance. The scope of the claims are broader than the enabling and the rejection of the broad claimed language is in accordance with the above decision of In re Fisher Fischer and Fiers v. Sugano.**

10           21.           **No claim is allowed.**

15           22.           **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20           A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

30           23.           Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is (703) 308-2034 and fax number (Art Unit 1808) is (703) 305-7401. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

40           H.J.Lilling: HJL  
(703) 308-2034  
Art Unit 1808  
November 05, 1996

*Herb Lilling*  
HERBERT J. LILLING  
PATENT EXAMINER  
GROUP 180 - ART UNIT 1808